REMARKS

Claims 25-32 have been canceled herein, and claims 33-36 have been added. Therefore, claims 2-7, 9-11, 13-17, 19, 20 and 33-36 are pending in the application. In addition, independent claims 5 and 15 have been amended. In view of the foregoing amendments and the following discussion, Applicant respectfully requests reconsideration of the patentability of the claimed subject matter.

Election/Restriction

Applicant acknowledges the constructive election made by the Examiner. While Applicant does not agree, Applicant withdraws claims 25-32 without prejudice to facilitate examination of the instant claims.

35 U.S.C. § 103 Rejections
Governing Legal Principles

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a prima facie case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03.

The Supreme Court set the standard for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al. (550 U.S. 127 S. Ct. 1727 (2007)*) to be "expansive and flexible" and "functional." However, the standard is not controlling, rather, the various noted factors only "can" or "might" be indicative of obviousness based on the facts. The Supreme Court in KSR enunciated the following principles:

> "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his

or her skill….[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). The Supreme Court while recognizing the need "to guard against slipping into the use of hindsight," acknowledged the following principles:

> [r]ejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

> [I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

> One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims.

Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993). The Supreme Court in *KSR* stated that:

> a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art.

An examiner may often find every element of a claimed invention in the prior art. "Virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. V. Union Oil Co.,* 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983), cert. denied, 464 U.S. 1043 (1984); see also *Richel, Inc. v. Sunspool Corp.,* 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the

claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.,* 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the <u>same</u> problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. The Supreme Court in *KSR* has also stated that:

> [o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place.

Further, the Supreme Court states that:

> The Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.

§ 103 Rejections

Claims 3, 5 and 9 have been rejected under § 103(a) as being unpatentable over U.S. Patent No. 5,583,543 to Takahashi et al. in view of U.S. Patent No. 5,710,831 to Beernink and further in view of U.S. Patent No. 6,459,442 to Edwards et al. and U.S. Patent No. 6,452,694 to Eisenberg et al. and in further view of Berman et al. (U.S. Patent No. 5,760,773). Applicant respectfully traverses this rejection.

Takahashi does not teach or suggest the present claims as amended. The Examiner has stated Figure 3c disclose the instant claims; however, in Figure 3c, the "very" in the Figure are user input strokes as stated:

> *Next, when the input pen 16 leaves the tablet 32, the handwritten character recognizing section 40 compares the trace coordinate with the basic character stroke of the handwritten character table 41 so as to obtain an optimum character code. The text editing section 38 processes in accordance with the optimum character code such that character "v" is added to the text memory 39 and character "v" is inserted before character "f", The character recognition of the first inputting area is carried out as soon as the input pen 16 is put down in a second inputting area of the window 22* (Takashi col 10 line 61- col 11 line 11).

Takahashi only teaches drawing strokes and not "displaying the text input strokes in the first touchscreen area as the strokes are made."

Beernink does not cure this deficiency, as it does not teach, alone or in combination, each and every element of the claims. Beernink does not teach or suggest "implementing in-place editing by replacing one or more previously recognized characters of the portion of the recognized text in the first touchscreen area with newly recognized one or more characters by recognizing new text input strokes made over the one or more previously recognized characters, in performing said editing, editing said recognition history, so that it reflects the resulting string after editing."

The addition of Edwards does not teach or suggest each and every element of the claims. The Examiner has stated that Edwards "discloses a recognition history of recognized text." Applicant respectfully disagrees. Edwards discloses a method of storing strokes, not recognized characters, storing all strokes including edit marks, and is representative of a "change history." For example, Edwards discloses a temporal history and not one of existing objects:

> *In accordance with the invention, freeform data in the form of strokes can be recovered after being erased (i.e., deleted) from the display. Because the data is in the common form of strokes it is not stored and identified by a user assigned identifier (e.g., a name) and filing location (e.g., directory)", this clearly states that it stores strokes and not recognized characters.* (Col 8 Lines 41-45)
>   . . .
> *Using the undo command 614 and the redo command 606, the user can access any past state of a selected segment.* (Col 9 lines 23-25).

The present invention as claimed stores <u>recognized</u> characters. For example, when a character is deleted, it is removed from the history. As another example, when a character is changed, then the entry in the history is replaced with the new recognized character.

With regard to the applicability of Eisenberg, Applicant does not claim what the Examiner asserts. Applicants have amended to the claim to "changing the recognized text in said first touchscreen area, where said text is selected by dragging a boundary around said text within said first touchscreen area" to clarify. As such, Eisenberg does not add anything to the combination.

With regard to Berman, the Examiner states "Berman discloses a draggable scroll

controller." Applicant respectfully disagrees. Berman discloses scrolling windows not "a draggable scroll controller within the first area for scrolling the portion of the recognized text displayed in said first area." Combining Berman with Takahashi does not result in the present invention as claimed.

None of the references, alone or in combination, teach or suggest each and every element of the present claims. Furthermore, Applicant notes that the Examiner is combining five references with teachings that are not interrelated but instead teach away from the combination suggested by the Examiner because they are simply independently known in the prior art. The Examiner is respectfully requested to reconsider the rejections based on the arguments presented here and withdraw the above rejections.

Claims 2, 13, 15, 20 22 and 24 have been rejected under § 103(a) as being unpatentable over *Takahashi, Beernink, Edwards* and *Eisenberg* in view of U.S. Patent No. 6,256,009 to Lui et al. ('*Lui*'). Applicant respectfully traverses this rejection.

Takahashi or Lui do not teach or suggest the present claims as amended. The present claims state "scrolling the portion of the recognized text in said first area and scrolling said second area in a simultaneous manner as new text input strokes are recognized to accommodate new input characters." This amendment is supported by the specification:

> *Figure 7 shows diagrams depicting the coordination of the first touchscreen area 501, the scroll controller 520, and the insertion point 510. The diagram on the left of Figure 7 shows insertion point 510 in the first field. The diagram on the right of Figure 7 shows insertion point 510 in the second field. Thus, it should be noted that the "focus" of touchscreen area 501 follows the insertion point 510. While the characters displayed in touchscreen area 501 can be changed by, for example, draggable navigation or draggable scrolling, the characters displayed in touch in area 501 can also change simply by moving the insertion point 510 within touchscreen area 502 (e.g., touching with a stylus).* (Spec. Page 16 lines 18-27)

Accordingly, Applicant respectfully requests these rejections be withdrawn.

Claim 4 has been rejected under § 103(a) as being unpatentable over *Takahashi, Beernink, Edwards* and *Eisenberg*, and *Berman* in view of U.S. Patent No. 5,546,538 to Cobbley et al. ('*Cobbley*'). Applicant respectfully traverses this rejection. As argued above, the five reference combination of Takahashi, Beernink, Edwards, and Berman does not teach or suggest each and every element of independent claim 5. As such, the addition of Cobbley cannot teach

or suggest dependent claim 4. Accordingly, Applicant respectfully requests this rejection be withdrawn.

Claim 7 has been rejected under § 103(a) as being unpatentable over *Takahashi, Beernink, Edwards, Eisenberg*, and *Berman* in view of U.S. Patent Application Publication No. 2002/0143831 to Bennett ('*Bennett*'). Applicant respectfully traverses this rejection. As argued above, the five reference combination of Takahashi, Beernink, Edwards, and Berman does not teach or suggest each and every element of independent claim 5. As such, the addition of Bennett cannot teach or suggest dependent claim 7. Accordingly, Applicant respectfully requests this rejection be withdrawn.

Claim 14 has been rejected under § 103(a) as being unpatentable over *Takahashi, Beernink, Edwards, Eisenberg, Berman* and *Lui* in further view of *Cobbley*. Applicant respectfully traverses this rejection. As argued above, the six reference combination of Takahashi, Beernink, Edwards, Eisenberg, Berman and Lui does not teach or suggest each and every element of independent claim 15. As such, the addition of Cobbley cannot teach or suggest dependent claim 14. Accordingly, Applicant respectfully requests this rejection be withdrawn.

Claims 16 and 18 have been rejected under § 103(a) as being unpatentable over *Takahashi, Beernink, Edwards, Eisenberg, Berman* and *Lui* in view of *Berman*. Applicant respectfully traverses this rejection. Claim 18 has been canceled obviating the rejection for this claim. With regard to claim 16, as argued above, the six reference combination of Takahashi, Beernink, Edwards, Eisenberg, Berman and Lui does not teach or suggest each and every element of independent claim 15. As such, the addition of Berman cannot teach or suggest dependent claim 16. Accordingly, Applicant respectfully requests this rejection be withdrawn.

Claim 17 has been rejected under § 103(a) as being unpatentable over *Takahashi, Beernink, Edwards, Eisenberg, Berman* and *Lui* in view of *Bennett*. Applicant respectfully traverses this rejection. As argued above, the six reference combination of Takahashi, Beernink, Edwards, Eisenberg, Berman and Lui does not teach or suggest each and every element of independent claim 15. As such, the addition of Bennett cannot teach or suggest dependent claim 17. Accordingly, Applicant respectfully requests this rejection be withdrawn.

Claim 19 has been rejected under § 103(a) as being unpatentable over *Takahashi, Beernink, Edwards, Eisenberg, Berman* and *Lui* in view of U.S. Patent No. 5,889,888 to Marianetti et al. ('*Marianetti*'). Applicant respectfully traverses this rejection. As argued above, the six reference combination of Takahashi, Beernink, Edwards, Eisenberg, Berman and Lui does not teach or suggest each and every element of independent claim 15. As such, the addition of Marianetti cannot teach or suggest dependent claim 19. Accordingly, Applicant respectfully requests this rejection be withdrawn.

New Claims

New claims 33-36 have been added. Applicant respectfully requests consideration of these claims in light of the above arguments for the independent claims from which they depend.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections, and that they be withdrawn. The Examiner is invited to telephone the undersigned representative if an interview might expedite allowance of this application.

Respectfully submitted,

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